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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,185	04/13/2004	Valentin Oprescu-Surcobe	CE11125R	3710
22917	7590	11/21/2005	EXAMINER	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			CAI, WAYNE HUU	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/823,185	OPRESCU-SURCOBE ET AL.
	Examiner Wayne Cai	Art Unit 2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 October 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-33 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-33 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

This Office Action is in response to Amendment dated 10/21/2005, and also Request for Continued Examination dated 10/24/2005.

Response to Arguments

1. Applicant's arguments filed have been fully considered but they are not persuasive.

In the Remarks:

- The Applicants assert that "monitoring the location of the mobile station is different than monitoring **messaging and messaging responses of the MS**, as recited by the claims. Nonetheless, the claims further recite wherein the messaging and messaging responses **do not explicitly specify a presence state of the MS or a presence state change by the MS.**"
- Also, the Applicants provide a formula of how to determine the inherency (i.e., "If X in doing Y necessarily did Z, then doing Z would be inherent to doing Y.), and question the Examiner "Why is inferring a presence state inherent to the description of monitoring the location of a mobile in the cited portion of Magee? On what basis does the Examiner make this assertion?"

In response to the arguments, independent claims 1, and 28, both recite "monitoring, by a wireless communications network, messaging and messaging

responses of a mobile station (MS), wherein the messaging and the messaging responses **do not explicitly specify** a presence state of the MS or a presence state change by the MS". Since "**do not explicitly specify**" is vague in meaning, one skilled in the art would expressly conceptualizes that it might specify, or it might not; and if it might, then it could be anything since it is not explicitly specified.

Furthermore, the Examiner would like to give the broadest reasonable interpretation to the phrase "messaging and messaging responses of a mobile station (MS)" (i.e., the signal, information, or data transmits between the wireless communications network and a mobile station.) In the cited reference, Magee teaches or suggests that the presence server 70 manages the presence state for mobile station or device 10 and supports searches for new contacts in its database (paragraph 0009). Clearly, Magee teaches or suggests a communication or connection between the presence server 70 and the mobile station or device 10. Hence, Magee teaches or suggests "messaging and messaging responses of a mobile station (MS).

In response to the question asked by the Applicants, the Examiner would like to take an opportunity to apply the provided formula in this situation; thereafter clarify on why inferring a presence state is inherent to the description of monitoring the location of a mobile in the cited portion of Magee, and what basis the Examiner made the assertion.

In accordance to the given formula, "if X in doing Y necessarily did Z, then doing Z would be inherent to doing Y." The Examiner then must prove that if monitoring messaging and messaging responses of a mobile station (MS), in doing inferring a

change in the presence state of the MS necessarily did monitoring the location of the MS, then doing monitoring location of the MS would be inherent to doing inferring a change in the presence state of the MS.

As explained above, Magee discloses that the presence server 70 manages the presence state for the mobile station (see paragraph 0009) (i.e., inferring a change in the presence state of the MS). By doing so, Magee teaches in paragraph 0014 that when location server 60 detects the mobile station 10 within a particular geographic area which presence services are available, location server 60 sends a signal which triggers presence server 70 (i.e., monitoring messaging and messaging responses of a mobile station). Hence, monitoring location of the MS would be inherent to do inferring a change in the presence state of the MS.

Therefore, the Examiner rejected based on the basis provided by the Applicants. Also, previous rejection was consistent with Applicants' formula and therefore, it was still proper. The rejection below serves as information purposes only.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5-6, and 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Magee et al. (hereinafter "Magee") (US 2004/0198379 A1).

Regarding claim 1, Magee discloses a method for enabling wireless presence-based services comprising:

- monitoring by a wireless communications network, messaging and messaging responses of a mobile station (MS), wherein the messaging and the messaging responses do not explicitly specify a presence state of the MS or a presence state change by the MS (figure 2, boxes 110 and 112);
- inferring, by the wireless communications network, a change in the presence state of the MS based upon the monitoring (paragraph 0014);
- communicating, by the wireless communications network, the state change to a presence server (paragraph 0014).

Regarding claim 3, Magee discloses the method of claim 1 as described above. Magee further discloses, wherein communicating the state change comprises communicating the state change to the presence server via internet messaging (paragraphs 0009 & 0014).

Regarding claim 5, Magee discloses the method of claim 1 as described above. Magee further discloses, wherein inferring comprises:

inferring the MS presence state has changed when the presence state of the MS indicates that the MS is present and messaging is detected that indicates MS activity from the group consisting of powering down, deregistering, entering an unavailable

mode, handing off outside the wireless communication network, and involved in other communication (paragraph 0014).

Regarding claim 6, it is inherent that the method of inferring comprises: inferring the MS presence state has changed when the presence state of the MS indicates that the MS is non-present and messaging is detected that indicates MS activity from the group consisting of powering up, registering, exiting an unavailable mode, handing off into the wireless communication network, and performing other communication because of the reasons rejected in claim 5.

Regarding claim 27, since the examiner rejects claim 1 because of the reasons above. It is inherent that the control function communicates and infers a change in the presence state of the MS based upon monitoring.

Regarding claim 28, Magee discloses a wireless communications network comprising:

- wireless transceiver equipment adapted to receive messaging and messaging responses of a mobile station (MS) (figure 1, items 20 & 30);
- a wireless presence proxy, communicatively coupled to the wireless transceiver equipment (figure 1, item 50),
- adapted to monitor the messaging and the messaging responses of the MS, wherein the messaging and the messaging responses do not explicitly specify a presence state of the MS or a presence state change by the MS (figure 2, boxes 110 & 112),

- adapted to infer a change in the presence state of the MS based upon the monitoring (figure 2, box 112),
- adapted to communicate the state change to a presence server (paragraph 0009).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2, 4, 7-26, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magee in view of Chen et al. (hereinafter "Chen") (US 2003/0157945 A1).

Regarding claim 2, Magee discloses the method of claim 1 as described above. Magee, however, fails to disclose the messaging responses comprise responses from the group consisting of a page response, a shod data burst (SDB) acknowledgment, a status response message, a short message service (SMS) acknowledgment, and a layer 2 acknowledgment.

In a similar endeavor, Chen discloses a method and apparatus for delivering information to a dormant target mobile. Chen further discloses, wherein the messaging responses comprise responses from the group consisting of a page response, a shod data burst (SDB) acknowledgment, a status response message, a short message

service (SMS) acknowledgment, and a layer 2 acknowledgment (figures 4 & 5, and its descriptions).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the messaging responses in order to acknowledge whether or not the device is still in communication.

Regarding claim 4, Magee discloses the method of claim 1 as described above. Magee, however, fails to disclose communicating the state change comprises communicating the state change to the presence server via Session Initiation Protocol (SIP) messaging. Chen discloses, wherein communicating the state change comprises communicating the state change to the presence server via Session Initiation Protocol (SIP) messaging (paragraphs 0024-0026).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the Session Initiation Protocol (SIP) messaging because it is one of the common IP protocols being used for registration.

Regarding claim 7, Magee discloses the method of claim 1 as described above. Magee, however, fails to disclose signaling, by the wireless communications network, the MS with messaging to which the MS is required to respond. Chen discloses, further comprising:

- signaling, by the wireless communications network, the MS with messaging to which the MS is required to respond (paragraphs 0051 & 0052, and figure 4, item 414 or 422).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to signal by the wireless communication network in order to communicate with the MS.

Regarding claim 8, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses, wherein messaging to which the MS is required to respond comprises messaging from the group consisting of a page, a short data burst (SDB) message, a status request message, and a short message service (SMS) message (figures 4 & 5, and its descriptions).

Regarding claims 9 and 33, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses:

- wherein monitoring comprises maintaining last-known-location information for the MS based on the messaging and the messaging responses (paragraph 0064),
- wherein signaling the MS comprises signaling the MS in a group of at least one cell based on the last-known-location information for the MS (paragraph 0064).

Regarding claim 10, Magee and Chen disclose the method of claim 9 as described above. Chen further discloses, wherein the last-known-location information comprises location information of a type from the group consisting of a cell ID, a base station ID, and a list of cell IDs (paragraphs 0057 and 0060).

Regarding claim 11, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses, wherein signaling the MS is triggered by an

event from the group consisting of an expiration of a periodic time interval, an expiration of a random time interval, and receiving a request from the presence server (paragraphs 0058 and 0064).

Regarding claim 12, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses, wherein monitoring comprises receiving, by the wireless communications network, a messaging response in response to the signaling and wherein the method further comprises:

- inferring, by the wireless communications network, no change in a presence state of the MS based upon the monitoring, confirming, by the wireless communications network, the presence state to a presence server (paragraph 0064).

Regarding claims 13, 14, and 32, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses:

- wherein monitoring passed after signaling the MS in which no response to the signaling has been received (paragraph 0064),
- wherein the no response within the period of time is a messaging response (paragraph 0064),
- wherein inferring comprises inferring a change in the presence state of the MS based upon the messaging response when the presence state of the MS indicates that the MS is present (paragraph 0064).

Regarding claim 15, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses:

- wherein the wireless communications network comprises a mobile switching center (MSC) (figure 5, box "MSC/VLR") and a base station (BS) (figure 5, box "BSC"),
- wherein signaling the MS comprises signaling the MS in a paging area indicated by the MSC (paragraph 0058, and figure 5).

Regarding claim 16, Magee and Chen disclose the method of claim 15 as described above. Chen further discloses, wherein monitoring comprises updating last-known-location information for the MS based on a messaging response to the signaling (paragraph 0064 and figure 5).

Regarding claim 17, Magee and Chen disclose the method of claim 7 as described above. Chen further discloses:

- wherein the wireless communications network comprises a control function and a base station (BS) (figure 5, boxes "BSC" and "MSC/VLR"),
- wherein the control function sends a signaling request message to the BS (figure 5, "Paging Request"),
- wherein signaling the MS comprises signaling by the BS in response to the signaling request message (figure 5, "Page Response").

Regarding claim 18, Magee and Chen disclose the method of claim 17 as described above. Chen further discloses, wherein the control function comprises a packet control function (PCF) (figure 4, box "PCF").

Regarding claim 19, Magee and Chen disclose the method of claim 17 as described above. Chen further discloses, wherein the wireless communications

network comprises a mobile switching center (MSC) and wherein the MSC comprises the control function (figure 4).

Regarding claim 20, Magee and Chen disclose the method of claim 17 as described above. Chen further discloses, wherein the wireless communications network comprises a mobile switching center (MSC), and a packet control function (PCF), wherein the control function is distributed between the MSC and the PCF (figure 4, see boxes “MSC/VLR”, “PCF”, and reference numbers 406 & 408).

Regarding claim 21, Magee and Chen disclose the method of claim 17 as described above. Chen further discloses, wherein the signaling request message comprises an A9-Short Data Delivery message (figure 4, item 406).

Regarding claim 22, Magee and Chen disclose the method of claim 21 as described above. Chen further discloses, wherein the signaling request message indicates a signaling location within which to signal the MS (paragraph 0057).

Regarding claim 23, Magee and Chen disclose the method of claim 17 as described above. Chen further discloses, wherein the BS sends an indication to the control function of whether a response from the MS was received (figure 4, items 406 & 408).

Regarding claim 24, Magee and Chen disclose the method of claim 23 as described above. Chen further discloses, wherein the indication to the control function comprises an A9-Short Data Ack message (figure 4, item 408).

Regarding claim 25, Magee and Chen disclose the method of claim 17 as described above. Chen further discloses, wherein the BS receives a messaging response from the MS in response to the signaling (figure 4, item 420).

Regarding claim 26, Magee and Chen disclose the method of claim 25 as described above. Chen further discloses, wherein the messaging response comprises a layer 2 acknowledgment from the MS (figure 4, item 422).

Regarding claim 29, Magee discloses the wireless communications network of claim 28 as described above. Magee, however, fails to disclose the presence server comprises a presence server from the group consisting of an instant messaging (IM) server and a push-to-talk (PTT) server.

In a similar endeavor, Chen discloses a method and apparatus for delivering information to a dormant target mobile. Chen further discloses, wherein the presence server comprises a presence server from the group consisting of an instant messaging (IM) server and a push-to-talk (PTT) server (paragraphs 0028-0032).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the presence server to communicate with other devices.

Regarding claim 30, Magee discloses the wireless communications network of claim 28 as described above. Magee, however, fails to disclose the messaging responses comprise responses from the group consisting of a page response, a short data burst (SDB) acknowledgment, a status response message, a short message service (SMS) acknowledgment, and a layer 2 acknowledgment. Chen discloses, wherein the messaging responses comprise responses from the group consisting of a

page response, a short data burst (SDB) acknowledgment, a status response message, a short message service (SMS) acknowledgment, and a layer 2 acknowledgment (figure 4 and its descriptions).

Regarding claim 31, Magee discloses the wireless communications network of claim 28 as described above. Magee, however, fails to disclose the wireless presence proxy is further adapted to signal via the wireless transceiver equipment the MS with messaging to which the MS is required to respond. Chen discloses, wherein the wireless presence proxy is further adapted to signal via the wireless transceiver equipment the MS with messaging to which the MS is required to respond (paragraphs 0051-0052).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the wireless presence proxy that is coupled with other devices to provide authorization for location based services.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Cai whose telephone number is (571) 272-7798. The examiner can normally be reached on Monday-Friday; 9:00-6:00; alternating Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Wayne Cai
Examiner
Art Unit 2681


ERIKA A. GARY
PRIMARY EXAMINER